# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/814,547 | 03/31/2004 | Richard Warren Hailey | 014586-9013-00 | 7402 |

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| 1131 7590 04/19/2006 | | EXAMINER | |
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| CHICAGO, IL 60601 | | 2178 | |

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/814,547 | HAILEY ET AL. |
| | Examiner | Art Unit |
| | David Faber | 2178 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)☒ Responsive to communication(s) filed on <u>31 March 2004</u>.

2a)☐ This action is **FINAL**.    2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)☒ Claim(s) <u>1-30</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>31 March 2004</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>7/19/2004</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.     This office action is in response to the application filed 31 March 2004.

**This office action is made Non-Final.**

2.     Claims 1-30 are pending. Claims 1, 14-16, and 28 are independent claims.

### *Information Disclosure Statement*

3.     The information disclosure statement filed 19 July 2004 fails to comply with the

provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because a number of references

listed in "Other Prior Art" on 1449B form fail to list the date of for that reference that was

published.  It has been placed in the application file, but the information referred to

therein has not been considered as to the merits.  Applicant is advised that the date of

any re-submission of any item of information contained in this information disclosure

statement or the submission of any missing element(s) will be the date of submission for

purposes of determining compliance with the requirements based on the time of filing

the statement, including all certification requirements for statements under 37 CFR

1.97(e).  See MPEP § 609.05(a).

### *Drawings*

4.     The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: 190 and 192 in FIG 12.  Corrected drawing sheets in compliance with 37

CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5.      The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "195" has been used to designate both citation and elements in FIG 12 and table elements in FIG 13.  Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6.      The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: data table 330, and data 332.  Corrected drawing sheets in compliance with

37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

7.      The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "370" has been used to designate composition element, font element, field modifiers, and Field Table in FIG 22.  Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

## *Claim Rejections - 35 USC § 112*

8.      The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9.      Claims 11, and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

10.     Claims 11, and 27 recite the limitation "creating a schema having an internal interface element that is configured specify the usage of data resolved by an external interface element." Examiner is unable to locate a disclosure of the claim within the specification. Examiner is able to find "internal data or interface" within Paragraph 0058 in regards to the Claims; however, that use of words does not disclose an enablement to one in the skilled art since it does not explain an internal interface element.


11.     The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12.     Claims 3, 16-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13.     Claim 4 recites the limitation, "wherein establishing an architecture for a set of rules rules includes..." Examiner notices the claim includes a typographical error of accidentally repeating the same word twice, and therefore, throughout this Office action, Examiner views the limitation as, "wherein establishing an architecture for a set of rules includes..."

14.     Claim 11 recite the limitation, "creating a schema having an internal interface element that is configured specify the usage of data resolved by an external interface element." Examiner notices the claim sentence structure making it incomplete and a bit confusing to read. Therefore, throughout this office action, Examiner will view claim 11 as, "creating a schema having an internal interface element that is configured **to** specify the usage of data resolved by an external interface element."

15.     Independent Claims 16, and 28 recite the limitation, "processing the tree beginning at the root node." Examiner is unsure what Applicant means by the use of processing since the term process contains various definitions making the usage in the claim vague and indefinite of what the limitation is actually doing. Therefore, throughout this Office action, Examiner views the limitation as "going through the tree at the root node"

16.     Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon it depends.

## *Claim Rejections - 35 USC § 102*

17.     The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18.     Claim 1, 12-13, 16-17, and 28-30 are rejected under 35 U.S.C. 102(b) as being

anticipated by Poole et al (US Patent #6,006,242, patented 12/21/1999).

As per independent claim 1, Poole et al discloses a method:

- establishing an architecture for a set of rules to be used in documents that

    consist of a plurality of components; and  (Column 5, lines 1-10; FIG 1)

- creating a dynamic document structure (FIG 1; Column 1, lines 15-20) that

    can resolve to one or more instances of a document (FIG 2, Column 5, lines

    54-60) and that is configured to include one or more rules based on the

    architecture for a set of rules. (FIG 1; Column 5, lines 1-24)


As per dependent claim 12, Poole et al discloses a method:

- creating a static document structure that can be resolved into one or more

    instances of a document that includes at least some content that is

    determined before and some content that is unchanged during and after a

    resolution process. (Column 18, line 56 – Column 19, line 11: Discloses

    creation about static documents, and how static documents are different than

dynamic indicating static documents remain unchanged for many

transactions)

As per dependent claim 13, Poole et al discloses a method:

- providing a data set (Column 4, lines54-56) configured to be processable by

  one or more rules built on the architecture for a set of rules (Column 6, line

  34: rules that dictate the access and utilization of components; Claim 16)

As per independent claim 16, Poole et al discloses a method:

- creating a transaction data set; (Column 5, lines 3-7; Column 29, STEP 1:

  collecting transaction data by instantiating (or create) business objects.)

- retrieving one or more cross-referenced document components from a data

  base based on the transaction data set, the one or more document

  components configured to include one or more rules; (FIG 1, Column 5, lines

  10-24)

- processing the one or more cross-referenced document components in a

  processor to generate a tree having a root node; processing the tree

  beginning at the root node; (Column 4, lines 6-16: parsing a document

  creates a tree wherein inherently a tree is created that contains at least one

  root node. After parsing and during validating, process inherently starts at top

  of the tree at the root and work its way down the tree.)

- when a rule is encountered, evaluating the rule and replacing it with a value;

    (Column 45, lines 18-27: rules are evaluated, and replaces rules with objects

    presenting a value)

As per dependent Claim 17, Poole et al discloses a method:

- establishing an architecture for a set of rules  (Column 5, lines 1-10; FIG 1)

As per independent claim 28, Claim 28 recites similar limitations as in Claim 16

and is similarly rejected under Poole et al.

As per dependent claim 29, Claim 29 recites similar limitations as in Claim 17

and is similarly rejected under Poole et al.

As per dependent Claim 30, Claim 30 recites similar limitations as in Cl28 and is

rejected under rationale. Furthermore, Poole et al discloses establishing a list of data

structures. (Column 4, lines 53-56: a collection of documents is a list of documents)


### *Claim Rejections - 35 USC § 103*

19.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20.     Claims 2-6, 7-11, 14-15, 18-22, and 23-27 are rejected under 35 U.S.C. 103(a)

as being unpatentable over Poole et al (US Patent #6,006,242, patented 12/21/1999) in

further view of Harold et al (Harold et al, "XML in a Nutshell, Second Edition", printed

June 2002, pp 171, 378, 383, 398, 431, 438-439, 444-445, 448, and 451-452).

As per dependent claims 2-6, Poole et al fails to specifically disclose creating a schema having a condition element, a choose element, an iterators element, and a functions element. However, Harold et al discloses a condition element (xs:Boolean, Page 398; xsl:if, Page 439), choice element (xs:choice, Page 378), iterators element (xsl:for-each, iterates over the nodes that are identified, Page 438), and a functions element (xs:import, its function is to import, Page 383).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Poole et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes and allowing the user to define custom types.

As per dependent claim 7-11, Poole et al fails to specifically disclose creating a schema having an external interface element that is configured to be resolved into a value, wherein the value is chosen from a group that includes a set, an XML DOM node, and an XML DOM node list, and wherein the external data interface element is configured to have an entity reference attribute and a return type attribute, and having an internal interface element that is configured specify the usage of data resolved by an external interface element.. However, Harold et al discloses an param element (xsl: param, (receives a value) Page 444; xsl:with-param, (sends a value) p451) that sends/receives a named parameter (value) that contain attributes of a name and a select expression. (Page 445, 452) The name represents the parameter's name or

entity reference and the select expression that represented to return a value of a

particular type. (Page 431) In addition, the retrieved value can be a node-set (p431,

171), a collection of Xpath nodes. (p171) In addition, the xsl:template provides

information how data is used including the received value using xsl:param. (p444-445,

448)

It would have been obvious to one of ordinary skill in the art at the time of

Applicant's invention to have combined Poole et al's method with Harold et al's

disclosure since it would have provided the user the benefit of supplying the user with

information on assigning types to elements and attributes and allowing the user the

ability to retrieve the information from an outside source.


As per independent Claim 14, Poole et al discloses a method:

- creating a dynamic document structure (FIG 1; Column 1, lines 15-20) that

    can resolve to one or more instances of a document (FIG 2, Column 5, lines

    54-60) and that is configured to include one or more rules based on the

    architecture for a set of rules. (FIG 1; Column 5, lines 1-24)

Poole et al fails to specifically disclose creating a schema having a condition

element, a choose element, an iterators element, and a functions element, and having

an external interface element that is configured to be resolved into a value. However,

Harold et al discloses a condition element (xs:Boolean, Page 398; xsl:if, Page 439),

choice element (xs:choice, Page 378), iterators element (xsl:for-each, iterates over the

nodes that are identified, Page 438), and a functions element (xs:import, its function is

to import, Page 383). In addition, Harold et al discloses an param element (xsl: param, Page 444; xsl:with-param, p451) that receives a named parameter (value) that contain attributes of a name and a select expression. (Page 445, 452) The name represents the parameter's name or entity reference and the select expression that represented to return a value of a particular type. (Page 431) In addition, the retrieved value can be a node-set (p431, 171), a collection of Xpath nodes. (p171)

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Poole et al's method with Harold et al's disclosure since it would have provided the user the benefit of supplying the user with information on assigning types to elements and attributes, allowing the user to define custom types and retrieve the information from an outside source.

As per independent Claim 15, Claim 15 recites similar limitations in as in Claim 14 and Claim 12 combined, and is similarly rejected under Poole et al and Harold et al.

As per dependent claims 18-22, Claims 18-22 recite similar limitations as in Claims 2-6, and are similarly rejected under rationale.

As per dependent claims 23-27, Claims 23-27 recite similar limitations as in Claims 7-11, and are similarly rejected under rationale.

### Conclusion

21.    The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Black et al (US Patent #6,763,500): Discloses dynamic document generation using schemas.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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